

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL A. BORS, ANN R. HERMES,
JOSEPH M. ROKOWSKI and DAVID G. SPEECE

Appeal No. 1998-1834
Application No. 08/467,631

ON BRIEF

Before WINTERS, ROBINSON, and MILLS, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-3 and 5, which are all of the claims pending in this application.

REPRESENTATIVE CLAIM

Claim 1, which is illustrative of the subject matter on appeal, reads as follows:

1. A method for improving the dirt pick-up resistance of a dried coating formed from a coalescent-free aqueous coating composition comprising forming said coalescent-free coating composition, said composition comprising an aqueous emulsion-polymerized polymeric binder having a glass transition temperature from about -15°C to about $+15^{\circ}\text{C}$, said binder comprising from about 2% to about 20%, by weight based on the weight of said polymeric binder, of at least one copolymerized ethylenically-unsaturated active methylene monomer [emphasis added];
applying said coating composition to an indoor or outdoor architectural substrate; and
drying said coating composition, wherein said dried coating composition exhibits improved dirt pick-up resistance.

THE REFERENCES

The references relied on by the examiner are:

Bors et al. (Bors)	5,296,530	Mar. 22, 1994 (filed Jul. 28, 1992)
Spada et al. (Spada)	5,053,452	Oct. 01, 1991
Smith	3,554,987	Jan. 12, 1971

THE REJECTIONS

Claims 1-3 and 5 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as unpatentable over Bors¹, Spada or Smith.

On consideration of the record, we reverse each of these rejections.

DISCUSSION

As stated in In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990), “[r]ejection for anticipation or lack of novelty requires, as the first step in the inquiry, that all the elements of the claimed invention be described in a single reference.” Here, the examiner has not established that Bors describes a “coalescent-free” coating composition as recited in claim 1. Nor has the examiner established that Bors describes a coating composition comprising “an aqueous emulsion-polymerized polymeric binder having a glass transition temperature from about -15°C to about +15°C.”

¹ As the case is briefed before us, Bors is relied on under 35 U.S.C. § 102(b). Bors does not reasonably appear to be prior art within the meaning of 35 U.S.C. § 102(b). However, the patent does appear to constitute prior art under 35 U.S.C. § 102(e). Appellants have not disputed the examiner’s position that Bors constitutes prior art to this invention.

Furthermore, with regard to the § 103 aspect of the rejection, the examiner has not explained how a person of ordinary skill would have been led from “here to there,” i.e., from the composition of Bors to the “coalescent-free” coating composition of appellants comprising “an aqueous emulsion-polymerized polymeric binder having a glass transition temperature from about -15°C to about +15°C.” Therefore, the examiner has failed to establish that Bors constitutes sufficient evidence to support a conclusion of obviousness under 35 U.S.C. § 103. In fact, based on our review of the Bors patent in its entirety, we find that Bors teaches away from a “coalescent-free” coating composition as that term is defined in appellants’ specification, page 4, third full paragraph. Bors states that “useful emulsion polymers will generally have T_g s under 60°C, since these polymers, with sufficient coalescent, will form good quality films at ambient temperatures” (col. 5, lines 59-62). The working examples of Bors disclose coating compositions having relatively high amounts of coalescent.

Likewise, the examiner has not established that Spada or Smith describes or suggests appellants’ “coalescent-free” coating composition comprising “an aqueous emulsion-polymerized polymeric binder having a glass transition temperature from about -15°C to about +15°C.”

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On this record, appellants alone disclose a method for improving the dirt pick-up resistance of a dried coating formed from a coalescent-free aqueous coating composition containing an aqueous emulsion-polymerized polymeric binder having a glass transition temperature from about -15°C to about +15°C.

We are mindful that when the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the burden of persuasion shifts and applicant has the burden of showing that they are not. In re Spada, 911 F.2d at 708, 15 USPQ2d at 1658; In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). On this record, however, the examiner has not established a sound basis to justify shifting the burden to appellants to demonstrate that the prior art compositions are not the same or substantially the same as that of appellants. It is not enough, as the examiner seems to believe, that the prior art discloses an aqueous emulsion-polymerized polymeric binder containing an amount, by weight, of at least one copolymerized ethylenically-unsaturated active methylene monomer which embraces the amount recited in appellants' claims.

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The examiner's decision rejecting claims 1-3 and 5 is reversed.

REVERSED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
DOUGLAS W. ROBINSON)		
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
DEMETRA J. MILLS)	
Administrative Patent Judge)	

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